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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,184	07/11/2001	James A. McFarlin	45565/FLC/M785	1160

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EXAMINER
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DURAN, ARTHUR D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/904,184

Applicant(s)

MCFARLIN ET AL.

Examiner

Arthur Duran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 1-51 have been examined.

#### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-8, 10-12, 15-25, 27-29, 32-42, 44-46, 49-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell (2001/0048222) in view of Evans (2002/0036654).

Claims 1, 8, 18, 25, 35, 42: Mitchell discloses a computer implemented method for producing marketing materials for a retail establishment, comprising:

receiving marketing material information from a corporate sponsor (Fig. 4; Fig. 5);

generating a marketing material completed design using the corporate sponsor marketing material information (Fig. 4; Fig. 5)

transmitting the marketing material completed design to a printer for production of the marketing materials upon receiving corporate sponsor approval (Fig. 4; Fig. 5).

Also, note that Mitchell discloses the interaction of the advertiser, retailer, designer, printer (Fig. 4).

Mitchell further discloses the above features of receiving, generating, transmitting, designing, printing at the following citations:

“[0011] In the practice of the method of the present invention, an advertiser

initiates a cooperative promotion to sell its goods or services. A promoter identifies retail establishments with customer demographics suitable for the advertised goods and/or services. The materials are designed and manufactured for distribution to the retail establishments.

[0034] A cooperative promotional advertising method using the advertising material set 2 is disclosed. FIG. 4 is a schematic diagram of the main participants. An advertiser 40 can be any entity with a product, i.e. goods and/or services, to sell. The advertiser 40 can involve an advertising agency 42, which would engage the promoter 44. Alternatively, the advertiser 40 can deal directly with the promoter 44. The advertising materials 2 are designed by a material designer 46 for production by a material manufacturer 48. A design for the advertising materials 2 would include such features as the name, the total coupon count, the award structure, the graphics, and the product advertising 16.

[0038] FIG. 5 is a flow chart of the co-promotional method of advertising of the present invention. The method is started by an advertiser 40 initiating a promotion of its goods and/or services. An advertising campaign is designed, with input from the product information provided by the advertiser 40. The retailers 50 are selected according to various demographic, marketing and related criteria. The design and license of the award structure and the advertising/promotional materials 2 is accomplished to most effectively market the goods and/or services of the promoter 44 and to create the broadest

possible appeal to the customers 54 of the retailers 50. The materials 2 are manufactured by a material manufacturer 48 and are sold and distributed to the retailers 50 through a network of vendors or distributors 52.

[Claim] 7. A cooperative advertising method, which includes the steps of: a. providing an advertiser with a product; b. engaging an advertising agency to advertise said product; c. engaging a promoter to promote said product; d. engaging a designer to design a set of advertising materials; e. providing a set of advertising materials including a predetermined number of coupons and a point-of-purchase advertising display; f. providing each said coupon with front and back faces and a plurality of break-open windows accessible from said front face; and g. printing on said front face an advertisement for purchase of said product at a savings greater than the price of said coupon.”

Mitchell does not explicitly disclose transmitting the marketing material completed design to the corporate sponsor for approval.

However, Evans discloses a sponsor company approving designs before the design is printed (Fig. 3, ‘authorize’, ‘product advertisements’; Abstract; below citations):

“[0005] Conventional business methods for creating advertising require that written materials and other documentation be provided by a customer (which we will refer to herein as the user) to third party graphic artists who design the layout. The customer must wait to receive a hard-copy proof from the artists, and then, after reviewing and revising the proof, resend the proof to the artists for redesign. When the proof is finally approved, the information must

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be delivered to a commercial printer to produce the advertisements in their final form. At each stage of the process, there can be substantial delays. After one or more redesigns, the customer must wait for a final proof and then, once approved, wait for the final product to be produced.

[0090] A user may review the preview to confirm that the draft advertisement as created using the present invention is acceptable in terms of content, design, quality, etc. If the user approves of the preview, the final advertisements may be printed, and preferably, in accordance with any printing specification that may have been provided by the user. In addition, the invention may offer the user an automatic checking feature of prices, quantities, inventory availability (e.g. in store availability or availability from distributor or manufacturer facilities) or other options (e.g. size, color, composition) against preset or predetermined parameters.”

Claim 2, 10, 19, 27, 36, 44: Mitchell and Evans disclose the method of claim 1, wherein the corporate sponsor marketing material further includes: pre-approved promotional calendars; special product offers; design templates; product images; graphic elements; and logos (Fig. 1a; Fig. 1b; Fig. 2; Fig. 3).

Also, it would be obvious to one skilled in the art that Mitchell’s printed promotions can include a variety of standard printed promotions. One would be motivated to do this in order to provide the printed promotion in form of interest to the user.

Claim 3, 20, 37: Mitchell and Evans disclose the method of claim 1. Mitchell further discloses interactions between a retailer and advertiser and promoter (Fig. 4). Therefore, it would be obvious that presenting to the retail establishment the marketing material information; and receiving from the retail establishment selected marketing material information, the selected marketing material information to be used to generate the marketing material completed design. One would be motivated to do this in order to better utilize relevant information when design and creating promotions.

Claim 4, 21, 38: Mitchell and Evans disclose the method of claim 3. Mitchell further discloses retailers selecting promotions (Fig. 5). Mitchell does not explicitly disclose design templates. However, Evans discloses design templates (Abstract and throughout the Evans disclosure). Therefore, it would be obvious to add Evans design template to Mitchell's retailer selecting advertising. One would be motivated to do this in order to provide advertisements of interest to the retailer.

Claims 5-7, 22-24, and 39-41: Mitchell and Evans disclose the above.

Mitchell further discloses designing the advertising and a variety of advertisement forms and styles including various coupons (Fig. 1a, 1b, 2, 3).

Evans discloses design templates and controlling composition (Paragraphs [90, 91]; Abstract).

Therefore, it would be obvious to one skilled in the art that Mitchell's advertisements can utilize templates or other design tools in order to design the advertisements. One would be motivated to do this in order to present advertisements of a good design.

Claim 11, 12, 28, 29, 45, 46. Mitchell and Evans disclose the above. Mitchell does not explicitly disclose a franchiser. However, it would be obvious to one skilled in the art that Mitchell's retailer can be a franchiser. One would motivated to do this because many retailers are part of a franchise and interacting with a franchise allows interaction with more stores.

Claims 15-17, 32-34, 49-51: Mitchell and Evans disclose the above. Mitchell does not explicitly disclose scheduling printing. However, Evans discloses tracking user design creation and printer orders and scheduling printer jobs (Evans, [89 thru 95]). Evans further discloses a variety of communications mediums (Evans [27, 54]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Evans tracking and print scheduling and variety of communications mediums to Mitchell's different communicating parties and order the manufacture/printing of designs. One would have been motivated to do this in order to better allocate the printing of designs.

3. Claims 9, 13, 14, 26, 30, 31, 43, 47, 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell (2001/0048222) in view of Evans (2002/0036654) in view of Chase (6,611,348).

Claims 9, 13, 14, 26, 30, 31, 43, 47, 48: Mitchell and Evans disclose the above. Mitchell does not explicitly disclose utilizing different resolutions. However, Evans discloses utilizing e-mail (Evans, [27, 54]). Chase discloses utilizing different resolutions during the design and approval process (Fig. 6; Fig. 9; and below):

“(72) DCM server 131 maintains the profiles in the DCM database 132 which includes asset tables 1102 and user profile tables 1104. User profile table



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1104 includes a plurality of user profiles, at least one for each customer of central service facility 105. Each customer profile, in turn, can be broken down into group profiles, for example, departmental profiles for marketing, manufacturing, sales staff, and outside customers, or clients; and individual profiles, for example, individuals who prepare printed documents, individuals who must review prices, and individuals who must approve catalog or advertising copy. Thus, each customer may have a plurality of group profiles, and each of those group profiles may have a plurality of individual profiles. Each nested category of profiles is inherited. For example, an individual profile inherits the profile of the group to which he is assigned and the group inherits the profile of the customer to which he is assigned. These profiles can be remotely edited by a customer administrator, for example, at end user facility 300 or printing company facility 400" (col 15, lines 35-55).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Evans utilization of communication technologies and Chase utilizing of different resolutions during the design and approval process to Mitchell's design and printing process. One would have been motivated to do this in order to allow better communications and between the different parties involved.

### ***Conclusion***

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a) Brown discloses templates and approving designs for printing:

“[0046] The Download Command Area 71 will be available to the end-user in the case that the template developer has specified that any fully populated template can be immediately downloaded by the end-user. In such a case, a "download" button 73 will appear after the first population choice has been made and previewed. Pressing the button 73 will present the end-user with a choice regarding the format of the final high-resolution print ready file. The choices currently being offered are PDF, EPS, and TIFF. Once the choice is made and submitted, the server will be requested to encapsulate all resources such as the fonts, images, and layout into the final image file. The end-user will then be presented with the ability to navigate his hard-drive, locate a directory to place the file, and then download the print-ready file to his hard drive. All print-ready files are automatically compressed to expedite the download process over slow connections. In the case that the template developer placed an "approval" restriction on the template, the final compositions must be submitted for approval. Thus, instead of a "download" button, a "submit layout" button is placed within the Download Action Area. Once pressed, the approver will be notified that a particular advertisement populated with end-user's choices is awaiting approval. The end-user will be given feedback indicating that the image has been submitted for approval, and will have to wait for the approver to agree that the image meets pre-defined specifications. At this point, the approver can view the image, make edits to

the composition using the same end-user interface, or reject the advertisement.

In the case of approval, the end-user will be sent a piece of e-mail indicating the new acquired "approved" status and a special URL to go and download his image (at this point all of the same download options will be available to the end-user). In the case of rejection, the end-user will also be notified via e-mail, and a special URL will be supplied allowing him to return to his composition in progress, make necessary edits/changes, and re-submit the changes into the approval process once again. After the approval, the advertisement is ready for printing. In addition, the downloaded version can be used for other outputs as well, such as internet banner advertisements."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Arthur Duran', is positioned above the printed name.

Arthur Duran  
Primary Examiner  
1/19/2006